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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,441	03/07/2002	Jun-Ichi Yamato	Q68863	7655

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EXAMINER	
DUNN, MISHAWN N	

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/091,441	YAMATO ET AL.	
	Examiner	Art Unit	
	Mishawn N. Dunn	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 March 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The limitation "the **compression** of data of the program **is made by displaying** the same frames a plurality of times **to reconstruct image data having less data of difference**" in claims 10 and 22 is a relative phrase which renders the claim indefinite. It is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to whether the applicant is performing compression or trick play. Is the term “difference” referring to the difference between the frames in compression and recompression or the difference between the frames from encoding, as cited earlier in the claim?

4. Claims 7 and 19 recite the limitation "the upper limit value." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer data signal embodies in a carrier wave is non-statutory.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4, 6, 8, 12-14, 16, 18, 20, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaneko et al. (US Pat. No. 6,671,454).

7. Consider claim 1. Kaneko et al. teaches a program recording device which receives a broadcast program and accumulates data of the program, comprising: a recording unit which records the data of the program (col. 10, lines 63-67; fig. 9); a compression setting storing unit which stores, for each compressing timing, a re-compression condition which is a condition of starting a compression of a program and an encoding method used in the compression of the program; a re-compression scheduler which is repeatedly activated, selects programs satisfying the re-compression condition among the recorded data of programs in the recording unit, and designates the encoding method used in the compression of the selected programs by referring to the compression setting storing unit; and a re-compressing unit which compress data of

the selected programs in the encoding method designated by the re-compression scheduler (col. 13, line 60 – col. 14, line 26).

8. Consider claim 2. Kaneko et al. teaches the program recording device of claim 1, wherein, in the compression setting storing unit, the re-compression condition and the encoding method are established for each importance of a program, and the re-compression scheduler selects programs which satisfy the re-compression condition which corresponds to an importance of each of the programs and the next compressing timing (col. 15, lines 32-44).

9. Consider claim 4. Kaneko et al. teaches the program recording device of claim 1, wherein, in the compression setting storing unit, the re-compression condition and the encoding method are established for each attribute of a program, and the re-compression scheduler selects programs which satisfy the re-compression condition which corresponds to an attribute of each of the program and the next compressing timing (col. 15, lines 45-54).

10. Consider claim 6. Kaneko et al. teaches 6. The program recording device of claim 1, wherein the re-compression condition is a condition that a program to be processed is compressed when a predetermined period passes from when the previous compression of data of the program is performed (col. 14, lines 27-60).

11. Consider claim 8. Kaneko et al. teaches the program recording device of claim 1, wherein the encoding method includes a deletion of data of the program (col. 13, lines 48-55).

12. Consider claim 12. Kaneko et al. teaches the program recording device of claim 1, wherein the compression of data of the program is made by encoding in an encoding method which produces a volume of data less than a volume of original data before the encoding method is executed (col. 13, lines 53-55).

13. Method claims 13, 14, 16, 18, 20, and 24 are rejected for the same reasons as discussed in the corresponding device claims above.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 3, 5, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (US Pat. No. 6,671,454) in view of Graves et al. (US Pat. No. 5,410,344).

17. Consider claim 3. Kaneko et al. teaches all the claimed limitations as stated above, except the program recording device of claim 2 further comprising: an automatic recording unit which automatically records the data of the program according to a user's taste and registers an importance representing a degree of coincidence between the user's taste and a taste of the program, wherein the registered importance is related to the corresponding program.

However, Graves et al. discloses an automatic recording unit which automatically records the data of the program according to a user's taste and registers an importance representing a degree of coincidence between the user's taste and a taste of the program, wherein the registered importance is related to the corresponding program (col. 5, line 44 – col. 6, line 52).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to automatically record the data of the program according to a user's taste and register an importance representing a degree of coincidence between the user's taste and a taste of the program, in order to select programs based on content and preference.

18. Consider claim 5. Kaneko et al. teaches all the claimed limitations as stated above, except the program recording device of claim 4, wherein the attribute includes a type of a program.

However, Graves et al. discloses that the attribute includes a type of a program (col. 4, lines 64-67; fig. 3).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to include a type of a program as an attribute, so the user can find a specific desired program in a short amount of time.

19. Method claims 15 and 17 are rejected for the same reasons as discussed in the corresponding device claims above.

TTQ 6/25/06

20. Claims 9, 21, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (US Pat. No. 6,671,454) in view of Alexander et al. (US Pub. No. 2002/0104094).

21. Consider claim 9. Kaneko et al. teaches all the claimed limitations as stated above, except the program recording device of claim 1, wherein the compression of data of the program is made by reducing the number of frames of image data to be displayed per a second.

However, Alexander et al. discloses that the compression of data of the program is made by reducing the number of frames of image data to be displayed per a second (pg. 1, para. 006, lines 11-13).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to compress the data of the program by reducing the number of frames of image data to be displayed, in order to reduce the size of a video file.

22. Consider claims 25-27. Kaneko et al. teaches all the claimed limitations as stated above, except a recording medium readable by a computer, tangibly embodying a program of instructions executable by the computer to perform a program recording method.

However, Alexander et al. discloses a recording medium readable by a computer, tangibly embodying a program of instructions executable by the computer to perform a program recording method (pg. 5, para. 0041, lines 22-27).

The Examiner takes official notice that it is well known in the art to encode a computer readable medium with a computer program. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use, to modify Kaneko et al. in order to allow a reproducing apparatus to playback images more efficiently.

23. Method claim 21 is rejected for the same reason as discussed in the corresponding device claim above.

24. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (US Pat. No. 6,671,454) in view of Wilkinson (US Pat. No. 6,160,844).

25. Consider claim 11. Kaneko et al. teaches all the claimed limitations as stated above, except the program recording device of claim 1, wherein when image data which are included in the data of the program and include a group consisting of first frames which are independently encoded and second frames which are next to the first frames

and encoded by using the difference between the frames are used, the compression of data of the program is made by increasing the number of frames consisting of the group.

However, Wilkinson discloses that when image data which are included in the data of the program and include a group consisting of first frames which are independently encoded and second frames which are next to the first frames and encoded by using the difference between the frames are used, the compression of data of the program is made by increasing the number of frames consisting of the group (col. 9, line 66 – col. 10, line 4).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, to compress the data of the program by increasing the number of frames consisting of the I, P, and B frames, in order to reduce the size of a video file.

26. Method claim 23 is rejected for the same reason as discussed in the corresponding device claim above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is 571-272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mishawn Dunn
June 25, 2006